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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/729,341

10/16/1996

OPHIRA R. AHARONSON

3864

7590

05/05/2004

RINES AND RINES  
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CONCORD, NH 03301

EXAMINER

NGUYEN, CHANH DUY

ART UNIT

PAPER NUMBER

2675

12

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/729,341

Applicant(s)

AHARONSON ET AL.

Examiner

Chanh Nguyen

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 20-42, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 20-42, 57 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on February 11, 2004 and declaration Ralph Rodriguez filed on January 23, 2004 have been entered and considered by examiner.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-11, 20-42 and 57-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 32 copied from Cotte's reference (U.S. Patent No. 5,499,108) recite "wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". However, there is no description in the specification to support the feature of the placement alone is sufficient to initiate said drawing nor means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data. The closest disclosure in the specification is as follows:

(a) Figure 1 of the application shows a monitor (H2), but does not disclose the feature of " means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

(b) On page 18, lines 14-18 of the specification discloses a master mode which the scanner automatically starts scanning, but does not discloses the limitations "means for displaying, in response to said replacement, a plurality of user-selectable options for processing said image data".

(c) On page 22, last line to page 23, line 2, discloses that "the user may choose to use a scanner for data input by picking operation from a menu or typing a specification", but does not disclose the feature " means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". For example, the specification does not disclose a menu displayed on the screen. The menu mentioned in the specification may be placed on the keyboard before replacement. Even the menu of the specification is displayed on the monitor, but the specification does not disclose the limitation "means for displaying, in response replacement..."

No where in the specification discloses the limitation "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

Dependent claims 8-9 and 23-24 recite the limitations "'scanning means sends an interrupt to said computer in response to said replacement" and "'said image data periodically polls said input device". However, nowhere in the specification discloses

such limitation above. Page 18, lines 14-18 of the specification describes a master mode with the host receives the scanned data into "spool" directory where it is stored for application to retrieve it, but does not mention the limitations "interrupt" nor "periodically polls" as recited in the claims.

Independent claims 20 and 26 recite the limitation " a plurality of user selectable options for processing said image data wherein said placement alone is sufficient to initiate display of said options". Again, nowhere in the specification discloses this limitation for the same reason as addressed in claim 1.

Independent claim 57 has similar problem as previously discussed on the independent claims 1, 20, 26 and 32 above. No where in the specification discloses "wherein said inserting is sufficient to initiate said drawing, and said computer comprising means for displaying the scan image data and means operable in response to said inserting of the document for initiating communications protocol with the computer for a plurality of user-selectable options for processing said image data" as recited in claim 57. It is noted that claims 57-58 recite the same limitation as claims 1-2 as stated by applicant on page 10 of the Remarks filed on February 11, 2004. That is "newly presented claims 57 and 58 precisely track claims 1 and 2".

The remaining claims 2-11, 21-25, 27-31 and 33-42, 58 are rejected to as being dependent upon a rejected base claims.

In view of lacking written description, no art rejection has been applied since the specification does not support the limitations recited in the claims 1-11 and 20-42.

***Response to Arguments***

4. Applicant's arguments filed February 11, 2004 and the declaration of Ralph Rodriguez filed on January 23, 2004 have been fully considered but they are not persuasive.

On page 9, lines 1-5 of the Remarks, applicant argues that "Never, in response to applicant's status requests, or oral and written communications with the first Examiner, over a six-year period, did the first Examiner ever raise any issue of adequacy of applicant's specification to support a single one of these claims—only the continuing promise of the declaration of an interference soon". However, there is no record of the promising statement "declaration of an interference" in the application. Since the claims of the application are copied from the re-exam application number 90/004,486 as stated in the suspension letter, the first examiner must be careful reviewing both re-exam application as well as the matter of copied claims in this application.

On page 9, second paragraph, applicant argues that "the present examiner has not answered the –MPEP- Section. 2307.04—specifically restricts the use of such a suspension to a cases "otherwise in condition allowance". Examiner has answered this question in the last office action. That is because first, the claims of the application are copied from the reexam application number 90/004,486 as stated in the suspension letter. Secondly, if the applicant finds an error of the suspension, then a petition can be made by applicant so that the suspension can be withdrawn because there is no record indicating that any claims are allowed.

On page 9, third paragraph, applicant stated that “the first Examiner thus clearly issued the suspension understanding of allowability to applicants”. However, there is no record in the application indicating the first Examiner issued the suspension understanding of allowability nor applicant raised the issue of allowability upon the suspension with the first examiner.

On page 9, fourth-fifth paragraphs, applicant argues that “the first Examiner had no such ground (certain not §112) and did not assert any”. In fact, the first examiner did not issue any ground rejection nor allowance except suspension letter because of the reason copying claims from the re-exam application. Applicant did not even mention nor raise the issue of allowance with the first Examiner if suspension is used.

On page 9, last two paragraphs applicant argues that “the present Examiner has not explained under what authority he can ignore these rules and make his own rules and have his own point of view, contrary to the express provision of the MPEP rules , which are binding upon the examining corps”. Examiner disagrees with applicant this point of view because the present examiner does not reorient the point of view of a previous examiner. If the previous examiner specifically indicates that there is no 112 to all the limitations of the copied claims from the re-exam application by applicant, then the present examiner will withdraw his 112 ground rejection.

As to the declaration of Ralph Rodriguez, the declaration of Ralph Rodriguez has been fully considered but it is not persuasive because of the following reasons:

Start at page 3, paragraph 8 of the declaration, the declaration states that "Long before the filing of the above application, hundreds of thousands of scanners interfaced or communicated with host computer all over the world,--and for three basic and universal thoroughly well-known protocols: (1) for instant automatic display of the scanned information data signals on the computer screen; and/or (2) for storing and memory for later display, and (3) for a menu of user-selectable options or functions indicated on the display". However, the declaration does not provide any evidence to support the statement above, specially the feature of automatic display of the scanned information data signals and automatic display of a menu of user selectable options in response to the replacement. Secondly, the menu selection is not obvious or inherent for any application in the art because it requires larger memory to store the function of menu which some device may not have it. Thirdly, the menu selection is well-known in the art to display the display screen. However, if the specification of the invention does not disclose it, then the menu selection should not be claimed. For example, many other features in the art of computer such as flash memory, OLED display screen, CD, DVD are well-known, but does not obvious or inherent to equip the listed above to all the computer. Some does have CD, some does not. Some has flash memory, but others do not have it for different reasons.

As to paragraph 10 of the declaration, the declaration states that "the examiner, with respect (i.e. the placement alone is sufficient to initiate said drawing), is absolute in error". However, the claims 1 and 32 require that wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in



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response to said placement, a plurality of user-selectable options for processing said image data". Examiner does not break this limitation in two parts as the declaration does for analyzing his rejection. For example, examiner emphasizes on the limitations "means for displaying, in response to said replacement, a plurality of user-selectable options for processing said image data" which is not disclosed in the specification as analyzed in sections (a) , (b) and (c) of the rejection.

As to paragraph 11 of the specification, the declaration states that "As one skill in this art, reading the application and including the reference to "menu" in column 7, line 52 and knowing that , as before stated, in the port connection of all scanner to "IBM PC" computer in that era (column 6, lines 7-10), protocol universally involved initially and automatically displaying the menu on the computer screen upon hook-up to the scanner , I must strongly state that the specification this positively provides such a teaching, and that such display of the menu on the screen was also inherent for all scanner-computer connection protocol". However, it is not inherent when the facts do not provide to the specification. Secondly, the menu selection is not obvious or inherent for any application in the art because it requires larger memory to store the function of menu which some device may not have it. Secondly, examiner agrees with declaration that the menu selection is well-known in the art to display the display screen. However, if the specification of the invention does not disclose it, then the menu selection should not be claimed. For example, many other features in the art of computer such as flash memory, OLED display screen, CD, DVD are well-known, but does not obvious or inherent to equip the listed above to all the computer. Some does

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have CD, some does not. Some has flash memory, but others do not have it for different reasons. Thirdly, simply states "the user may choose to use a scanner for data input by picking operation from a menu or typing a specification" in column 7, line 52, does not fully support the limitation "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". Last but not least, the declaration does not provide any evidence to support the statement "inherent" or "well-known" the limitation "menu" or more specifically the limitation "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data" as stated by declaration.

As to paragraph 12 of the declaration, the declaration states that "the suggestion that menu may be placed on the keyboard, with respect, border on the ludicrous, and has no basis whatsoever in the description of the operation of the application, and indeed, is contrary to the established and universal operation of scanners with computers in the era of the filing of the application. However, examiner disagrees with the declaration statement above since the definition of a menu is simply a list of function to perform the operation of the device. Thus, the term "menu" is so broad that it can even read on the function keys such as F1-F12 or any function keys presented on the keyboard, not on the screen in response to the placement. It is noted that the specification of the invention does not specifically recite that the "menu" is displayed on the display screen in response to the placement.

As to paragraph 13 of the declaration, the declaration states that "Without this inherent menu display on the computer screen, the user had no information on which to

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select an option or function". Examiner disagrees with the statement above since many fax machine do not need the menu displayed on the screen to perform the operation of fax, and many computer do not display the function F1-F12 on the screen as the declaration presented. Even the menu in the specification displayed on the screen, it does not display in response placement as recited in the claims.

As to paragraph 14 of the declaration, examiner disagrees the interpretation of the term "display communication" cited on column 8, lines 2-5 as a menu. The display communication may be just a confirmation that the fax is successfully transmitted, not necessary a menu.

As to paragraph 15 of the declaration, the declaration presents the Figures 7C-7G and concludes that "To one skill in the art , this is clearly means the display of a menu of options or functions as applicant s describe them...". Examiner again disagrees with this statement because the "display status" command shown in block of Figure 7C is not necessary a menu, it could be just an indicator or confirmation that the master mode is operated.

As to paragraph 16 of the declaration, the declaration cites column 6, lines 17-19, column 6, lines 8-9 and column 5, lines 30-32 and concludes that these citation clearly teaches the claimed limitation "wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". Examiner disagrees with the declaration in this point of view, specially the citation "initiates communications protocols with the host computer", "outputting the...document

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–scanned data” (col. 6, lines 8-9) such that “the host receives the scanned data: (col. 6, lines 30-32). It is clear that the host receiving the scanned data is not necessary that the host displays the scanned data on the screen in response to the placement.

As to paragraph of 17 of the declaration, the declaration states that “With the insertion or placement of the document in the scanner in the scanner in the Master Mode (col. 8, line 3, on) initiating the display communication protocol, including SEND TO HOST DISPLAY STATUS COMMAND (Fig. 7C, before discussed), this causes the displaying of the universal protocol options menu, **always provided in 1992 era by scanner-computer interfacing**”. However, the declaration does not provide any evidence to support the statement “inherent” or “well-known” the limitation “menu” or more specifically the limitation “ means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data”.

As to paragraph 19 of the declaration, the declaration presents all the issues similar to the issues presented in paragraphs 1 through 18 and concludes that “the running display of scanned image data and storage are, of course, and were in 1992, the standard computer-scanner protocol, inherent in all such systems”. Again, the declaration does not provide any evidence to support the statement “inherent” or “well-known” the limitation “menu”, “display of scanned image data” or more specifically the limitation “ means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data”.

### Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanh Nguyen whose telephone number is (703) 308-6603.

If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Steven Saras can be reached at 305-9720.

**Any response to this action should be mailed to:**


Commissioner of Patents and Trademarks  
Washington, D.C. 20231


**or faxed to:**

**(703) 872-9306**

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

  
C. Nguyen  
April 30, 2004

  
CHANH NGUYEN  
PRIMARY EXAMINER